



DFW
AF

Application Serial No. 09/482,462
Atty. Docket No. 45900-000391/US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants: Per S. ANDERSEN et al.
Application No.: 09/482,462
Group No.: 3622
Filed: January 13, 2000
Examiner: Donald CHAMPAGNE
For: AN ADVERTISEMENT SALES AND MANAGEMENT
SYSTEM
Attorney Docket No.: 45900-000391/US

April 30, 2010

M/S APPEAL

Commissioner for Patents
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

THIRD SUPPLEMENTAL REPLY BRIEF

Sir:

In response to the Supplemental Examiner's Answer dated March 30, 2010, the Appellants submit this Third Supplemental Reply Brief. The Appellants also respectfully maintain their request for an Oral Hearing under 37 C.F.R. § 1.194(b) and note that the appropriate fee as specified under 37 C.F.R. §1.117(d) was paid with the Appellants' previous response of August 16, 2004.

REBUTTAL AND REMARKS

This second supplemental reply brief is in response to the Communication mailed June 28, 2007, the Appellants' petition for a one-month extension of time to August 28, 2007, having been filed by facsimile on July 30, 2007. The June 28, 2007 Communication indicates that Appellants' Reply Brief filed April 4, 2007, was not considered "because it is not in compliance with 37 CFR 41.41(a)(2). The reply brief contains prohibited new evidence, the 'Second Declaration under 37 CFR § 1.132' dated April 1, 2007, by Mr. Thomas Brandenburg," and providing the Appellant an opportunity to submit a paper in compliance with the requirements of 37 C.F.R. § 41.41(a)(2). The Appellants submit that the present filing is in full compliance with the requirements of 37 C.F.R. § 41.41(a)(2) and should, therefore, be entered into the record for this appeal.

The Examiner's Newly Proffered Interpretation of "Supporting" Is Improper

The Appellants contend that the Examiner's interpretation of the claim term "supporting" as "facilitating," being proffered for the first time almost seven years into the prosecution of this application, is both untimely and improper. Supp. Exm. Ans. at 2. The Appellants submit that the Examiner's definition is contrary to the requirements of MPEP § 2111.01 that the definition be reasonable "in light of the specification ... and consistent with the interpretation that those skilled in the art would reach." Indeed, the Appellants note that the Examiner has offered no

contemporaneous art-relevant definitions or interpretations, relying on only a single conclusory statement that appears to reflect only the Examiner's personal interpretation of this term.

Appellants submit that those skilled in the software arts would understand that a system accurately described as "supporting" a series of identified functions is a system that is capable of performing each of the identified functions. The Appellants further maintain that those skilled in the software arts would not consider a system that provides only a single improved function to be fairly characterized as "supporting" any additional functions, whether or not the additional functions could be considered to be "related" in some way to the improved function.

Accordingly, the Appellants maintain that the Examiner's redefinition of "supporting" as "facilitating" in order to characterize an "improved" ad entry system as "supporting" sales and/or management functions with respect to the entered ads is improper. As noted above, the Appellants maintain that an ad entry system, even an improved ad entry system that could be characterized as "facilitating" ad entry, would not be considered by one skilled in the art to comprise "a single system supporting entry, sales and management of several related advertisements in several media based on entry of a single advertisement order" as recited in each of the independent claims. The Appellants, therefore, maintain that redefining the term "supporting" as "facilitating" is improper and should be withdrawn as justification for maintaining the rejections of the pending claims under 35 U.S.C. § 103(a).

The Examiner's Interpretation of the First Declaration is Flawed

Although the Examiner's contends that in his First Declaration, Mr. Brandenburg "has acknowledged (para. 22 and 23) that the reference inventions might be combined" simply does not comport with the plain language of Mr. Brandenburg's first Declaration. Supp. Exm. Ans. at 3. Indeed, the Appellants submit that the qualifying language "*in case* Witek et al, and NEXPO '97 *were combinable*" (emphasis added), make Mr. Brandenburg's intentions in this regard quite plain and cannot reasonably be characterized as rebutting Mr. Brandenburg's unequivocal statement, which immediately precedes the paragraphs cited by the Examiner, that QPS (NEXPO '97) and Witek are "not combinable."

Allegations of Generic "Economic Advantages" Does Not Constitute Motivation

The Appellants also note that the Examiner identifies "economic efficiency" as the sole motivation for making the proposed combination, maintaining that "there is a widespread desire to economize." Supp. Exm. Ans. at 3. The Appellants submit, however, that it is both legally and logically insufficient to rely on only some generic "benefit" or "advantage" that the proposed combination would share with the claimed invention to justify the combination.

The Appellants submit that if the proposed combination results in an article or method including each of the claim elements, then the proposed combination must *necessarily* provide all of the same advantages as the invention. Indeed, any other result would be illogical. However, alleging that one skilled in the art would have been motivated to make the proposed

combination of references to achieve the alleged “advantage,” would effectively remove any need to identify some separate technical or logical motivation for the combination.

The Appellants submit, therefore, that relying on a generic “advantage” alone to justify a combination would render obvious every combination! The Appellants maintain that such “advantage” based reasoning may be improperly used to bypass the conventional technical obviousness analysis, particularly when neither citation to the cited references nor assertions regarding the knowledge in the art have been presented that may fairly be said to constitute motivation for one of ordinary skill in the art to make such a combination.

Because this circular “reasoning” can be applied to most, if not all, combination claims, relying on any “advantage” common to the invention and the Examiner’s proposed combination for the initial motivation to make the combination results in an “analysis” that is simply incapable of distinguishing between obvious and non-obvious inventions. The Appellants maintain that speculation regarding some generic “advantage” simply does not constitute legitimate objective evidence of a teaching or suggestion in the prior art or general knowledge in the art necessary to maintain a proper obviousness rejection.

Accordingly, unless and until the Examiner provides objective evidence and/or makes specific factual findings with respect to the motivation to combine references, *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002), the Appellants maintain that any proposed combination predicated solely on “economic efficiency” remains improper and should be withdrawn.

Shifting the Burden Regarding the Quark Teachings is Improper

As recognized by the Examiner, a “central issue is what the QPS 2.0 software was and was not capable of” at some time before the critical date. Accordingly, the Appellants maintain that the Examiner’s reliance on a third-party review of promotional materials published in late 1997 does not establish the actual capabilities of the QPS 2.0 software with the requisite degree of specificity. The Appellants further note that cited portions of NEXPO indicate only that the release of the QPS 2.0 software was estimated “at early next year [1998].” NEXPO at 26. Accordingly, the Appellants maintain that it has not been established that the QPS 2.0 software is actually valid prior art against the present application under any part of 35 U.S.C. § 102. Further to the extent that other systems and/or applications in addition to the QPS 2.0 software were reviewed in NEXPO, the Appellants maintain that there was no teaching or suggestion of a single system capable of accomplishing the “entry, sales and management of several related advertisements in several media based on entry of a single advertisement order” as recited in the claims.

Indeed, the Appellants maintain that in order to support the present obviousness rejections, it remains the Examiner’s burden to establish that the QPS 2.0 software reviewed in the NEXPO reference was, in fact, available before the critical date and did, in fact, provide the suggested functionality. The Appellants contend, therefore, that the Examiner’s current speculation regarding the availability and functionality of the QPS 2.0 software before the critical date, speculation which is based on only a third-party review of pre-release promotional

materials, does not even constitute “admittedly slim evidence” with regard to this predicate factual issue.

The Appellants contend, therefore, that until the Examiner produces appropriately dated materials or other evidence reflecting the *actual capabilities* of the released QPS 2.0 software and the *release date* for that software, there is no *evidence* of record sufficient to support a proper *prima facie* rejection under 35 U.S.C. § 103(a). The Appellants submit that in light of the lack of evidence sufficient to support a *prima facie* rejection, the burden of establishing evidence sufficient to support the rejection remains with the Examiner. According, until a valid *prima facie* rejection is established, the burden of presenting rebuttal evidence to overcome such a rejection has not been shifted to the Appellants.

CONCLUSION

Because the proposed combination of the Witek and NEXPO references do not teach or suggest all of the elements recited in those claims associated with Groups (i, ii, iii, iv) and because the Examiner has not yet identified evidence supporting the rejections of those claims associated with Groups (v, vi, vii), Appellants respectfully maintain that claims 1-50 are patentable over Witek and NEXPO, whether considered singly or in combination.

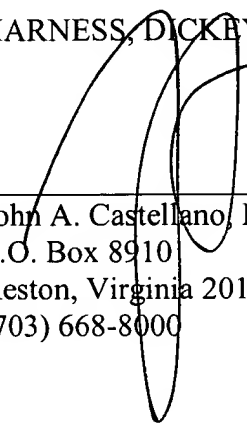
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By



John A. Castellano, Reg. No. 35,094
P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

JAC//pw